

Appl. No. 10/601,969
Amdt. dated February 13, 2006
Reply to Office Action of January 26, 2006

1. Status of the Claims.

Claims 1-12 and 21-24 are pending and under consideration in this application. This response contains no claim amendments and, therefore, the claims remain as submitted in the Request for Continued Examination filed June 23, 2005

2. Rejections to the Claims Under 35 U.S.C. §103.

Claims 1-12 and 21-24 were rejected under 35 U.S.C. §103 over the prior art illustrated in FIGS. 1-4 (the "Applicant's Prior Art") of the present application in view of U.S. Patent No. 2,027,684 to Fageol. More specifically, Examiner asserts that prior art FIGS. 1-4 show all the features of the claimed invention except at least one of the auxiliary wheels being dimensioned smaller than the trolley wheels. Examiner relies on wheels 27 as disclosing the claimed auxiliary wheels, and concludes that it would be obvious to modify the auxiliary wheels of prior art FIGS. 1-4 to have the smaller size of wheels 27 of Fageol. Applicant respectfully disagrees.

As noted in Applicant's response to the previous office action, it is well settled that prior art references are properly combined only where there is a suggestion, teaching, or motivation to combine them, and that suggestion, teaching, or motivation must come from the prior art references themselves. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998); See generally MPEP § 2143, page 2100-129. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01, page 2100-131 (citing *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990)). Furthermore, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP §2141.01(a).

Fageol discloses a rail and highway unit for transporting passengers and/or freight from the point of origin to the final destination utilizing both existing railways and existing highways without transferring mode of transportation. See Fageol, Col. 1, line 48- Col. 2, line

15. The rail and highway unit disclosed in Fageol includes a vehicle or trolley having wheels 6 and 27, which include pneumatic tires and are designed to travel along streets, highways and railways. Each of wheels 27 is equipped with flange 29, which engages the inside of track 28 to steer and guide the vehicle when operating along the railway. See Fageol Col. 6, lines 28-31. During normal operation, wheels 27 are held just above rail 28 such that the tread of wheels 27 does not contact rail 28. See Fageol Col. 6, lines 22-28. Wheels 27 only engage track 28 in the event that wheels 6 fail, i.e. due to deflation of the pneumatic tire. See Fageol Col. 7, lines 40-46; Col. 8, lines 15-25. The vehicle is powered by electricity which is conducted from an overhead conductor to the vehicle via conductor member 33. See Fageol Col. 6, lines 37-48. Examiner points to element 33 of Fageol as illustrating a hanging device. To the contrary, element 33 is a conductor element that conducts electricity from a conducting wire extending overhead of the vehicle to the vehicle to provide power to the vehicle. Element 33 does not act to hang or suspend anything from the overhead conducting wire. Practically speaking, Fageol discloses an electric mass transit/freight system having a trolley with pneumatic tires, which enable the trolley to travel on, and switch between, a variety of different travel paths including railway tracks, roads or highways.

There is nothing in the disclosure of Fageol that teaches, suggests or motivates one to combine any part of the Fageol vehicle with the movable wall panel system of the Applicant's Prior Art. The vehicle of Fageol does not serve the same or similar function as that served by the trolley of the claimed invention. The vehicle of Fageol does not suspend a wall panel, door or any other object from an overhead track and does not ride in an overhead track to move the suspended wall panels, door or any other object along the overhead track. Instead, the Fageol vehicle rides atop a track and supports passengers and freight atop the track.

In addition, Fageol is not in the field of Applicant's endeavor. Fageol does not relate to the field of suspended wall panel/door systems. Furthermore, Fageol is not relevant to the problem of suspending and moving wall panels smoothly along an overhead track. Fageol does not address the problem of smoothly negotiating X-intersections in an overhead track and crossing the gap created by such an intersection. Fageol also does not address the problems

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associated with compactly and efficiently stacking wall panels in a storage arrangement. Instead, Fageol addresses problems associated with the door-to-door delivery of passengers and freight including highway competition, complications of transfer between railway units and other modes of transport, and the excessive costs of operating heavy equipment such as trains.

For the reasons discussed above, Applicant respectfully submits that there is no teaching, suggestion or motivation to combine Fageol with Applicant's Prior Art and, further, that Fageol is non-analogous art and it would be improper to combine Fageol with Applicant's Prior Art. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

CONCLUSION

Applicant respectfully requests that action toward a Notice of Allowance be taken.

Applicant believes that no fees are due in connection with this submission. However, if any fees are necessary, please charge Deposit Account No. 02-0390, Baker & Daniels LLP.

Respectfully Submitted,

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